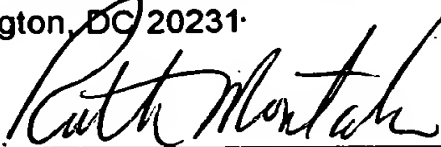


EXPRESS MAIL No.: EL 164 921 680 US

Deposited: October 1, 1998

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/ Ruth Montalvo

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Docket No.: GK-GEY-1020

Applicant(s): Andreas Gerhard BAAR, Wolfgang GEBEL, Ute IMHOF and Hannelore MIHALIK

Serial No.: 09/029,408 (Int'l Appli. No. PCT/EP96/04016 filed 12SEP96)

Filed: Concurrently herewith

For: PROCESS FOR PRODUCING MOULDINGS WITH A BARRIER LAYER MADE OF BIODEGRADABLE MATERIAL, AND MOULDINGS PRODUCED ACCORDING TO THIS PROCESS

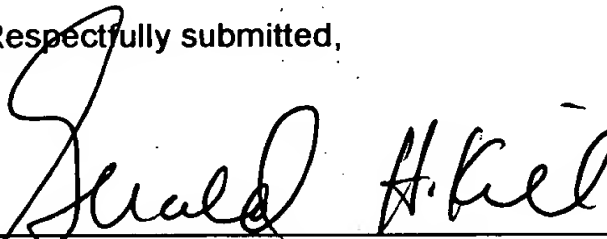
Box PCT
Assistant Commissioner of Patents
Washington, DC 20231

TRANSMITTED HERewith IS THE FOLLOWING

- X 1. PETITION PURSUANT TO 37 CFR 1.182;
- X 2. Transmittal - PTO-1390;
- X 3. Executed Declaration/POA
- X 4. Verified English translation of a Figure 4b and Fig 4b;
- X 5. Request for Refund;
- X 6. CHECKS for \$ 260.00 and \$ 130.00;

The Commissioner is hereby authorized to charge the deposit account any other fees required with this submission or to credit any overpayment to Deposit Account No: 13-0025.

Respectfully submitted,



Gerald H. Kiel - Reg. No. 25,116

GHK:ram

10/05/1998 PVDLPE 00000056 09029408

01 FC:154
02 FC:156

130.00 OP
130.00 OP

RECEIVED

09 OCT 1998

Legal Staff
International Division

EXPRESS MAIL No.: EL 164 921 680 US

Deposited: October 1, 1998

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/ Ruth M. Ntalv

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Docket No.: GK-GEY-1020
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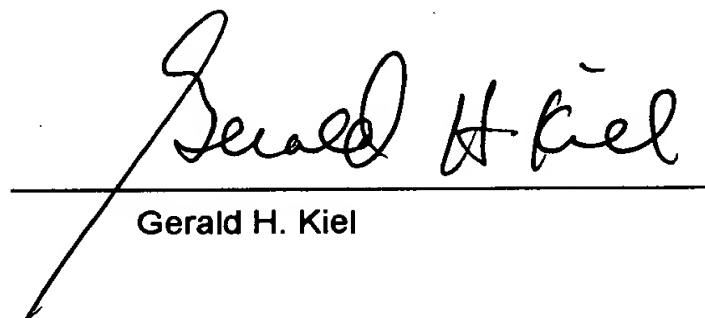
Box PCT
Assistant Commissioner of Patents
Washington, DC 20231

TRANSLATION CERTIFICATION

Gerald H. Kiel, being fluent in the German and English languages hereby certifies that the English translation of the German word indicated on the attached Fig. 4b is correct and accurate.

October 1, 1998

Date



Gerald H. Kiel

4

Attorney's Docket No. : **GK-GEY-1020**
U.S. Application No. : **09/029,408**
International Application No. : **PCT/EP96/04016**
International Filing Date : **SEPTEMBER 12, 1996 (12 SEPTEMBER 1996)**
Priority Date Claimed : **SEPTEMBER 12, 1995 (12 SEPTEMBER 1995)**
Title of Invention : **PROCESS FOR PRODUCING MOULDINGS WITH A BARRIER
LAYER MADE OF BIODEGRADABLE MATERIAL, AND
MOULDINGS PRODUCED ACCORDING TO THIS PROCESS**
Applicant(s) for (DO/EO/US) : **Andreas Gerhard BAAR, Wolfgang GEBEL, Ute IMHOF and
Hannelore MIHALIK**

Applicant herewith submits to the United States Designated/Elected Office (DO/EO/US) the following items and other information:

1. ☐ This is a **FIRST** submission of items concerning a filing under 35 U.S.C. 371.
2. ☒ This is a **SECOND** or **SUBSEQUENT** submission of items concerning a filing under 35 U.S.C. 371.
3. ☐ This express request to begin national examination procedures [35 U.S.C. 371 (f)] at any time rather than delay examination until the expiration of the applicable time limit set forth in 35 U.S.C. 371(b) and PCT Articles 22 and 39(1).
4. ☐ A proper Demand for International Preliminary Examination was made by the 19th month from the earliest claimed priority date.
5. ☐ A copy of the International Application as filed [35 U.S.C. 371(c)(2)]
 - a) ☐ is transmitted herewith (required only if not transmitted by the International Bureau)
 - b) ☐ has been transmitted by the international Bureau
 - c) ☐ is not required, as the application was filed in the United States Receiving Office (RO/US)
6. ☐ A translation of WO 97/10293 (~~the International Application~~) into English [35 U.S.C. 371(c)(2)]
7. ☐ Amendments to the claims of the International Application under PCT Article 19 [35 U.S.C. 371(c)(3)]
 - a) ☐ are transmitted herewith (required only if not transmitted by the International Bureau)
 - b) ☐ have been transmitted by the International Bureau
 - c) ☐ have not been made; however, the time limit for making such amendments has **NOT** expired.
 - d) ☐ have not been made and will not be made
8. ☐ A translation of the amendments to the claims under PCT Article 19 [35 U.S.C. 371(c)(3)]
9. ☒ An oath or declaration of the inventor(s) [35 U.S.C. 371(c)(4)]
10. ☐ A translation of the annexes to the International Preliminary Examination Report under PCT Article 36 [35 U.S.C. 371(c)(5)]

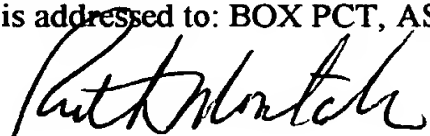
Items 11. to 16. below concern other document(s) or information included:

11. ☐ An Information Disclosure Statement under 37 C.F.R. 1.97 and 1.98
12. ☐ An Assignment document for recording. A separate cover sheet (PTO-1595) in compliance with 37 CFR 3.28 and 3.31 is included.
13. ☐ A **FIRST** preliminary amendment and Abstract
☐ A **SECOND** or **SUBSEQUENT** preliminary amendment
14. ☐ A substitute specification
15. ☐ A change of power of attorney and/or address letter
16. ☒ (other items or information) **Copy of Decision dated September 9, 1998 and Verified English translation of Fig. 4b and Figure 4b**

EXPRESS MAIL No.: **EL 164 921 680 US**

Deposited: **October 1, 1998**

I hereby certify that this correspondence is being deposited with the United States Postal Service Express mail under 37 CFR 1.10 on the date indicated above and is addressed to: BOX PCT, ASSISTANT Commissioner for Patents, Washington, DC 20231.



/Ruth Montalvo Date: **October 1, 1998**

17. The following fees are submitted:

BASIC NATIONAL FEE [37 CFR 1.492(a)(1)-(5)]:

CALCULATIONS

PTO USE ONLY

<input type="checkbox"/> Search Report has been prepared by the EPO or JPO.....	\$ 930.00		
<input type="checkbox"/> International preliminary examination fee paid to USPTO [37 CFR 1.482].....	\$ 720.00		
<input type="checkbox"/> No International preliminary examination fee paid to USPTO [37 CFR 1.482] but International search fee paid to USPTO [37 CFR 1.445(a)(2)].....	\$ 790.00		
<input type="checkbox"/> Neither International preliminary examination fee [37 CFR 1.482] nor International search fee [37 CFR 1.445(a)(2)] paid to USPTO.....	\$1,070.00		
<input type="checkbox"/> International preliminary examination fee paid to USPTO [37 CFR 1.482] and all claims satisfied provisions of PCT Article 33(1)-(4).....	\$ 98.00		
ENTER APPROPRIATE BASIC FEE AMOUNT:		\$.00	
Claims	Number	Number	Rate
	filed	extra	
Total Claims	-20=	x	\$ 22. =
Indep. Claims	-03=	x	\$ 82. =
<input type="checkbox"/> Multiple Dependent Claim(s) (if applicable)		+	\$ 270. =
TOTAL OF ABOVE CALCULATIONS:		\$.00	
Surcharge of \$130.00 for furnishing the oath or declaration later than [] 20 [X] 30 months from the earliest claimed priority date [37 CFR 1.492(e)]		\$ 130.00	
TOTAL OF ABOVE CALCULATIONS:		\$ 130.00	
Reduction by 1/2 for filing by small entity, if applicable. Verified Small Entity Statement must be filed. [Note 37 CFR 1.9, 1.27, 1.28]			
SUBTOTAL:		\$ 130.00	
Processing fee of \$130.00 for furnishing the English Translation later than [] 20 [X] 30 months from the earliest claimed priority date [37 CFR 1.492(f)]		\$ 130.00	
TOTAL NATIONAL FEE:		\$ 260.00	
Fee for recording the enclosed assignment [37 CFR 1.21(h)] The assignment must be accompanied by an appropriate cover sheet (PTO-1595) [37 CFR 3.28, 3.31]. \$ 40.00 per property +			
TOTAL FEES TO BE CHARGED:		\$ 260.00	
AMOUNTS TO BE REFUNDED OR CHARGED		REFUNDED CHARGED	\$ \$

Please charge my Deposit Account No. 13-0025 in the amount of \$.00 to cover the above fees and any other fees required with this submission .

☒ Enclosed is a check in the amount of \$ 260.00. (The Commissioner is hereby authorized to charge the deposit account the any other fees required with this submission or to credit any overpayment to Deposit Account No: 13-0025.

NOTE: Where an appropriate time limit under 36 CFR 1.494 or 1.495 has not been met, a petition to revive [37 CFR 1.137(a) or (b)] must be filed and granted to restore the application to pending status.

SEND ALL CORRESPONDENCE TO:

Gerald H. Kiel, Esq.

McAulay Nissen Goldberg Kiel & Hand, LLP

261 Madison Avenue

New York, NY 10016-2391

Gerald H. Kiel

Name (Tel. (212) 986-4090)

Signature

25,116

Reg. No.

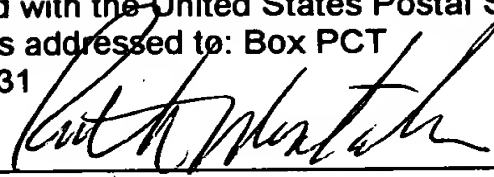
October 1, 1998

Date

EXPRESS MAIL No.: EL 164 921 680 US

Deposited: October 1, 1998

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/ Ruth M. Ntalv

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Docket No.: GK-GEY-1020
Applicant(s): Andreas Gerhard BAAR, Wolfgang GEBEL, Ute IMHOF and Hannelore MIHALIK
Serial No.: 09/029,408 (Int'l Appli. No. PCT/EP96/04016 filed 12SEP96)
Filed: Concurrently herewith
For: PROCESS FOR PRODUCING MOULDINGS WITH A BARRIER LAYER MADE OF BIODEGRADABLE MATERIAL, AND MOULDINGS PRODUCED ACCORDING TO THIS PROCESS

Box PCT
Assistant Commissioner of Patents
Washington, DC 20231

REFUND REQUEST

Sir:

The above-mentioned application was filed twice, on March 6, 1998 with the filing fee of \$ 2,684.00 (check no. 2411) and on March 12, 1998 with the filing fee of \$ 1,870.00 (check no. 2420).

In response to the Decision dated September 9, 1998 and a Petition Pursuant to 37 CFR 1.182 filed concurrently herewith, applicant requests a refund of \$ 2,684.00 minus any handling fees.

Please credit the overpayment to Deposit Account No. 13-0025.

Respectfully submitted,



Gerald H. Kiel - Reg. No. 25,116

GHK:ram

19 SEP 1998



UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office

Patent Cooperation Treaty
Legal Office

Address: Assistant Commissioner for Patents
Box PCT
Washington, D.C. 20231

Gerald H. Kiel, Esq.
McAuley, Fisher, Nissen, Goldberg, & Kiel
261 Madison Avenue
New York, New York 10016-2391

In re Application of
BAAR et al
Application No.: 09/029,408
PCT No.: PCT/EP96/04016
Int. Filing Date: 12 September 1996
Priority Date: 12 September 1995
Attorney's Docket No.: GK-GEY-1020
For: PROCESS FOR PRODUCING MOULDINGS
WITH A BARRIER LAYER MADE OF
BIODEGRADABLE MATERIAL AND
MOULDINGS PRODUCED ACCORDING
TO THIS PROCESS

COPI
DECISION

This application is before the PCT Legal Office for consideration of issues arising under 35 U.S.C. 371.

BACKGROUND

On 12 September 1996, applicant filed international application PCT/EP96/04016, which claimed priority of an earlier international application filed 12 September 1995. A copy of the international application was communicated to the United States Patent and Trademark Office from the International Bureau on 20 March 1997. A Demand for international preliminary examination, in which the United States was elected, was filed on 24 February 1997, prior to the expiration of nineteen months from the priority date. Accordingly, the thirty-month period for paying the basic national fee in the United States expired at midnight on 12 March 1998.

On 06 March 1998, applicant filed a transmittal letter for entry into the national stage in the United States, which was accompanied by, inter alia, the requisite basic national fee as required by 35 U.S.C. 371(c)(1); a preliminary amendment; an information disclosure statement (IDS); and copies of various papers related to international application PCT/EP96/04016. These papers were assigned US application number 09/029,408.

DOCKET

DUE OCT. 9, 1998 Reply to office Letter

On 12 March 1998, applicant filed a transmittal letter for entry into the national stage in the United States, which was accompanied by, inter alia, the requisite basic national fee as required by 35 U.S.C. 371(c)(1); a purported English translation; a preliminary amendment; and a letter requesting withdrawal of the application. These papers were assigned US application number 09/029,977.

DISCUSSION

As is evident from the above recited facts, applicant submitted two sets of papers to enter the national stage for the same international application. The end result for an international application designating the United States of America is a single U.S. national stage application. Therefore, the submission of two sets of national stage papers to enter the United States was improper.

The papers filed on 12 March 1998 have been placed in application number 08/029,408.

Applicant should use application number 08/029,408 in all future communications with the Patent and Trademark Office in regards to the U.S. national stage of international application PCT/EP96/04016.

It is not clear what applicant means by the letter filed 12 March 1998 requesting "withdrawal of the above-identified application which was filed March 6, 1998. A replacement application is being filed concurrently herewith." If applicant's intent is to withdraw the international application, such action can not be approved without a power of attorney. Furthermore, if applicant did withdraw the international application, entry into the national stage would not be permissible under 35 U.S.C. 366 which states, in part, "Subject to section 367 of this part, if an international application designating the United States is withdrawn or considered withdrawn, either generally or as to the United States, under the conditions of the treaty and the Regulations, before the applicant has complied with the applicable part requirements prescribed by section 371(c) of this part, the designation of the United States shall have no effect after the date of withdrawal and shall be considered as not having been made..."

Furthermore, since they are papers in both applications that are pertinent to the national stage, e.g. the IDS and the preliminary amendment in the papers filed on March 6, 1998 and the translation and the preliminary amendment filed on March 12, 1998 it is unclear whether applicant wishes for the papers filed on March 6, 1998 to be disregarded.

Applicant is required to file a petition and fee under 37 CFR 1.182 to explain what applicant means by his communication of March 12, 1998 and which preliminary amendment he wishes to have entered.

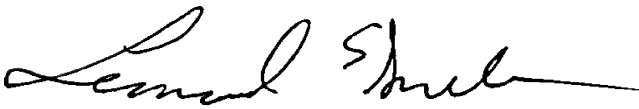
A review of the purported translation filed on 12 March 1998 reveals that in Figure 4b, the word "Probenmuster" has not been translated. Applicants attention is drawn to PCT Rule 49.5(d) which states, "If any drawing contains text matter, the translation shall be furnished either in the form of a copy of the original drawing with the translation pasted on the original text matter or in the form of a drawing executed anew." Because applicants did not comply with the rule, the translation is unacceptable under 35 U.S.C. 371(c)(2).

Applicant has not submitted an oath or declaration as required by 35 U.S.C. 371(c)(4).

CONCLUSION

A petition and fee under 37 CFR 1.182, a translation of Fig 4b accompanied by the processing fee for translations submitted later than 30 months from the priority date as required by 37 CFR 1.492(f), an oath or declaration and the surcharge for providing an oath or declaration later than 30 months from the priority date as required by 37 CFR 1.492(e) are required. Applicant is given ONE (1) MONTH in which to submit the above items. Extensions of time may be obtained under 37 CFR 1.136(a).

Any further correspondence with respect to this matter should be addressed to the Assistant Commissioner for Patents, Box PCT, Washington, D.C. 20231, with the contents of the letter marked to the attention of the PCT Legal Office.



Leonard E. Smith
PCT Legal Examiner
PCT Legal Office

Telephone: (703) 308-6461
Facsimile: (703) 308-6459